

Serial No. 09/703,748

REMARKS

The Applicants and the undersigned thank Examiner Basom for the careful review of this application. The Applicants also appreciate the Examiner Basom's and his supervisors time and consideration given during the telephonic interview conducted today (September 23, 2003). The Applicants have prepared this response in light of this discussion.

Claims 1-14 have been rejected, while Claims 15-18 remain withdrawn from consideration as being drawn to a non-elected invention. The Applicants acknowledge the finality of the restriction imposed by the Examiner. The Applicants elected with traverse but the Examiner did not find the Applicants' arguments persuasive. However, the Applicants have maintained the right to petition the requirement and to file any divisional applications as desired.

Upon entry of this amendment, Claims 1-18 remain pending in this application. The independent claims are Claims 1, 11 and 15. Consideration of the present application is respectfully requested in light of the above amendments to the application and in view of the following remarks.

Claim Objection under 37 C.F.R. § 1.75(c)

The Examiner objected to dependent Claim 10 under 37 C.F.R. § 1.75(c) as being of improper dependent form. The Applicants respectfully offer remarks to traverse this objection.

The Examiner states that Claim 10 is written in the form of a preamble made to depend on another claim. The Examiner elaborates that the preamble is not given patentable weight as it fails to breathe life, meaning, and vitality into the claims. The Examiner concludes that as such, the claim fails to further limit the subject matter of the subject matter of the claim upon which it depends.

The Applicants respectfully disagree with the Examiner and point out to the Examiner that dependent Claim 10 is in proper form. The Applicants direct the Examiner's attention to MPEP § 608.01(n) (8th Ed., August 2001), subsection III, first, second and sixth paragraph, page 600-77, which states the following:

"III. INFRINGEMENT TEST

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not

Serial No. 09/703,748

conceivably be infringed by anything which would not also infringe the basic claim.

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope...

...The fact that a dependent claim which is otherwise proper might relate to a separate invention which would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction. The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim if the product might be made in other ways." [Emphasis Supplied.]

The Applicants respectfully submit that independent Claim 1 describes a method for customizing nodes of a network diagram while dependent Claim 10 describes a computer readable medium having computer-executable instructions for performing the steps recited in independent Claim 1. This means that Claim 1 describes a process while Claim 10 describes an article of manufacture that includes all of the process steps described in independent Claim 1. Therefore, in light of the fact that dependent Claim 10 includes all of the steps of independent Claim 1, the Applicants respectfully submit that dependent Claim 1 is proper.

The Applicants further submit that independent Claim 1 and dependent Claim 10 of this application are analogous to product-by-process claims. MPEP § 608.01(n) (8th Ed., August 2001), subsection II, second paragraph, page 600-76 states the following:

Serial No. 09/703,748

"Note, that although 37 CFR 1.75(c) requires the dependent claim to further limit a preceding claim, this rule does not apply to product-by-process claims."

The Examiner's attention is also directed to MPEP § 2173.05(p) (8th Ed., August 2001) second paragraph which states the following:

"A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); In re Steppan, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process."[Emphasis Supplied.]

In light of the above MPEP sections that explain that a dependent claim is proper when it includes all of the limitations of its independent claim even if the dependent claim is in a different statutory class of subject matter relative to the independent claim, the Applicants respectfully submit that dependent Claim 10 of the present application is proper. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Rejections under 35 § 103(a)

The Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,704,028 to Schanel et al (hereinafter the "Schanel reference") in view of U.S. Patent No. 5,680,530 to Selfridge et al (hereinafter the "Selfridge reference"). The Applicants respectfully offer remarks to traverse these pending rejections.

Independent Claim 1

The rejection of Claim 1 is respectfully traversed. It is respectfully submitted that the Schanel and Selfridge references fail to describe, teach, or suggest (1) displaying one or more options in a first window for modifying one or more physical characteristics of nodes within a network diagram in a second window; (2) displaying a graphical preview of one node in the first window that indicates current selected options for physical characteristics and data

Serial No. 09/703,748

characteristics of a group of nodes; (3) displaying an updated graphical preview of one node in the first window in response to receiving the selection of the one or more options; and (4) applying the selected options to one or more nodes in a the network diagram which is contained within the second window, as recited in amended Claim 1.

The Schanel reference generally describes a graphics program that allows a user to create various types of diagrams such as flow charts, process flow charts, pareto charts, run charts, control charts, and cause-and-effect diagrams. In Figure 14 of the Schanel reference, a cause-and-effect diagram 330 is illustrated. See Figure 14 of the Schanel reference reproduced below.

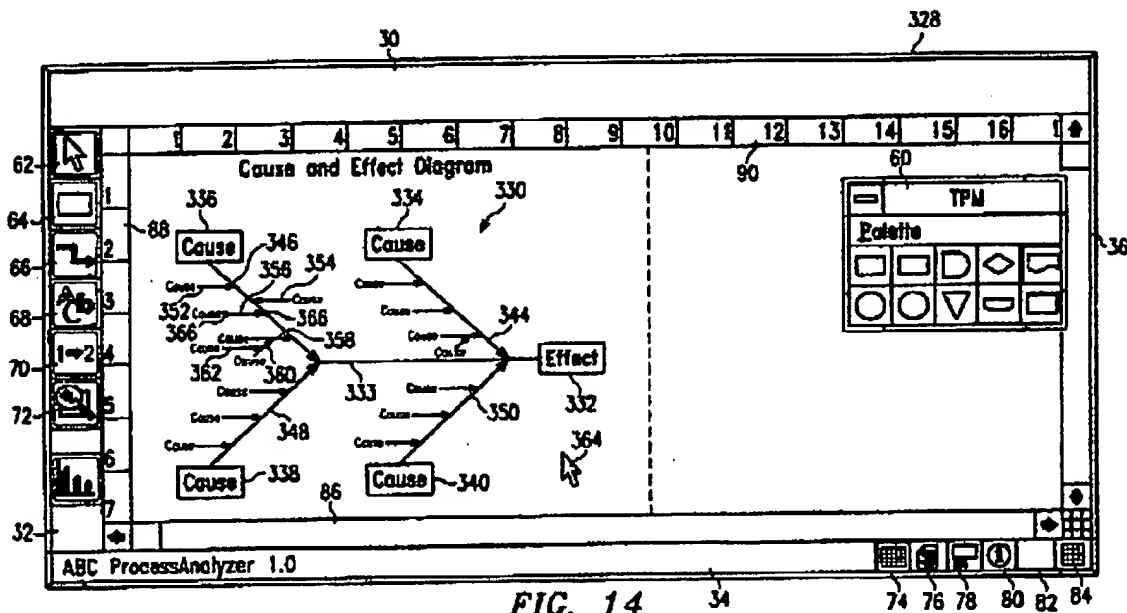


FIG. 14

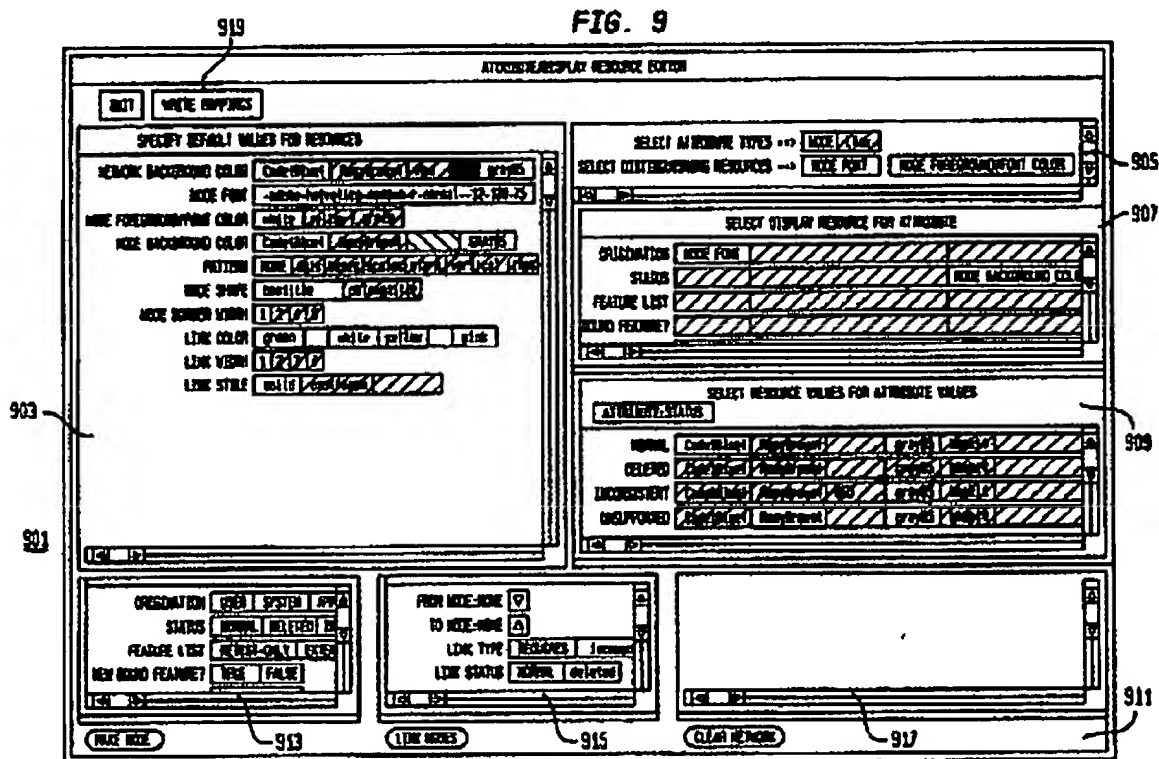
In Figure 14 reproduced above, a user can use a mouse pointer 364 to select shapes from a shape pallet 60 and place shapes in the window 30. While it may be argued that shape pallet 60 can be interpreted as a first window, this first window does not display a graphical preview of one node that indicates current selected options for nodes that correspond with the first window and display an updated graphical preview of one node in the first window in response to receiving a selection of the one or more options displayed in the first window, as recited in amended independent Claim 1.

The Examiner admits that the Schanel reference fails to provide any teaching of a preview. Those skilled in the art also recognize that to include a preview in the first window 60

Serial No. 09/703,748

would be not logical because this interface is used to build the diagram and not to display options for existing elements in the diagram.

In order to make up for the preview deficiency of the Schanel reference, the Examiner relies on Figure 9 the Selfridge reference and its corresponding written description to provide a teaching of a preview. Figure 9 of the Selfridge reference is reproduced as follows:



Specifically, the Selfridge reference in column 18, lines 5-15, states the following about the "preview" section 911 of Figure 9:

"Section 903 uses the techniques just described to select default values for resources. The list on the left shows the available resources and the list to the right of each resource shows the available values for the resource. Section 911 permits the user to preview the results of his selections in areas 905, 907, 909, and 903. Section 913 of section 911 permits a user to specify values of attributes for a feature represented by a node; section 911 permits the user to specify values of attributes for

Serial No. 09/703,748

links; again, the techniques of the other sections are used for selection. The results of the attribute selections is displayed in area 917."

In other words, while section 911 of the may be called a preview by the Selfridge reference, it is a preview of selected options displayed as only text or a text listing. The Selfridge reference does not teach any graphical previews of the nodes illustrating their physical characteristics. The Selfridge reference does not display a graphical preview of one node that indicates current selected options for a group of nodes. The Selfridge reference also does not display an updated graphical preview of one node in the first window in response to receiving a selection of the one or more options displayed in the first window, as recited in amended independent Claim 1.

In light of the differences between the claims and the references mentioned above, one of ordinary skill in the art recognizes that the Schanel and Selfridge references, alone or in combination, cannot anticipate or render obvious the recitations as set forth in amended independent Claim 1. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Independent Claim 11

The rejection of Claim 11 is respectfully traversed. It is respectfully submitted that the Schanel and Selfridge references fail to describe, teach, or suggest (1) displaying an indicator that shows a highlight filter is activated; (2) listing one or more categories of nodes for a network diagram; (3) displaying one or more options for modifying one or more physical characteristics of a category of nodes within a network diagram; (4) displaying one or more options for modifying one or more characteristics of data that is contained within respective a category of nodes within a network diagram; (5) displaying a highlight filter graphical preview of current settings for nodes that illustrates the physical characteristics and data characteristics of a category of nodes; (6) displaying an updated highlight filter graphical preview in response to receiving a selection of one or more of the options; and (7) applying the selected options to one or more nodes in a network diagram such that nodes of a category designated for highlighting relative to other nodes have the selected options of the highlight filter, as recited in amended Claim 11.

As noted and illustrated above, the Schanel or the Selfridge references do not provide any teaching of displaying a highlight filter graphical preview of current settings for nodes

Serial No. 09/703,748

corresponding to the highlight filter and displaying an updated highlight filter graphical preview in response to receiving a selection of one or more of the options. The Examiner admits that the Shanel reference does not provide any teaching of a preview. While the Selfridge reference makes reference to a preview, it does not provide any teaching of a graphical preview of current settings for nodes that illustrate the physical characteristics and data characteristics of a category of nodes, as recited in amended Claim 11. Instead, the Selfridge reference teaches a text based preview of selected options that do not comprise a highlight filter.

In light of the differences between the references and claims mentioned above, one of ordinary skill in the art recognizes that the Schanel and Selfridge references, alone or in combination, cannot anticipate or render obvious the recitations as set forth in amended independent Claim 11. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Dependent Claims 2-10, and 12-14

The Applicants respectfully submit that the above-identified dependent claims are allowable because the independent claims from which they depend are patentable over the cited references. The Applicants also respectfully submit that the recitations of these dependent claims are of patentable significance. Accordingly, reconsideration and withdrawal of the rejections of these dependent claims are respectfully requested.

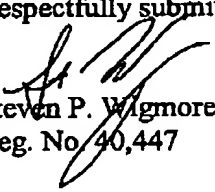
CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed on June 23, 2003. The Applicants and the undersigned thank Examiner Basom for the consideration of these remarks. The Applicants have submitted remarks to traverse the rejections of Claims 1-14. The Applicants respectfully submit that the present application is in condition for allowance. Such Action is hereby courteously solicited.

Serial No. 09/703,748

If the Examiner believes that there are any issues that can be resolved by telephone conference, or that there are any formalities that can be corrected by an Examiner's Amendment, please contact the undersigned in the Atlanta Metropolitan Area at (404) 572-2884.

Respectfully submitted,


Steven P. Wigmore
Reg. No. 40,447

King & Spalding
45th Floor
191 Peachtree Street, N.E.
Atlanta, Georgia 30303
404.572.4600
K&S Docket: 06576.105031 (MS#154663.1)

**RECEIVED
CENTRAL FAX CENTER**

SEP 24 2003

OFFICIAL